UNITED STATES DISTRICT COURT FOR THE DISTRICT OF UTAH CENTRAL DIVISION

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ALFWEAR, INC. *Plaintiff,* v. **ICON HEALTH & FITNESS** *Defendant.*	**COMPLAINT FOR TRADEMARK INFRINGEMENT AND DILUTION** **JURY TRIAL DEMANDED** Civil Action No. 2:17-cv-00476-EJF

COMPLAINT

Plaintiff Alfwear, Inc. ("ALFWEAR") for its Complaint against Defendant Icon Health & Fitness ("ICON") states and alleges as follows:

THE PARTIES

1. Plaintiff Alfwear is a Utah company with a principal place of business at 4884 South 300 West Murray, Utah 84107.

2. Upon information and belief, Defendant ICON is a Utah company with its principal place of business at 1500 South 1000 West Logan, Utah.

3. Upon information and belief, Defendant ICON is the owner and controller of the brand ALTRA RUNNING ("ALTRA").

JURISDICTION AND VENUE

4. This Court has subject matter jurisdiction over this action under 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331 and 1338 because it involves claims under the Lanham Act.

5. Venue in this district is proper under 28 U.S.C. §§ 1391 (b) - (c) and 1400(b) because ICON's contacts with this jurisdiction are sufficient to subject it to personal jurisdiction in this district.

6. The Court has person jurisdiction over ICON in this action because ICON has had, and continues to have, substantial, continuous and systematic contacts with the State of Utah and, this has purposefully availed itself of the privilege of conducting activities in this judicial district, thereby invoking the benefits and protections of the laws of the State of Utah.

BACKGROUND FACTS

7. Alfwear owns all right, title and interest in U.S. Trademark Number 3,572,281 ("Born mark") for the phrase "BORN IN THE MOUNTAINS".

8. Alfwear has been selling outdoor clothing, namely, jackets, shirts, pants, shorts, t-shirts a under the Born mark since it least as early as 2007. As a result of the efforts of Alfwear, Alfwear's sales of outdoor clothing under the Born mark has significantly grown over the years. The Born mark of Alfwear is well recognized in the United States as being synonymous with outdoor clothing. As a result of Alfwear's efforts, the Born mark has become famous as indicating Alfwear's outdoor

clothing.

9. As a result of Alfwear's quality products, great service and extensive advertising, Alfwear's clothing products have become well recognized and famous in the outdoor clothing industry in association with the Born mark.

10. Alfwear's line of products in the outdoor clothing industry has grown substantially over the years to the point where the Born mark rival the leading brands in sales within the outdoor clothing industry.

11. In the outdoor clothing industry, the Born mark products are not sold to discounters, but only to retailers known for selling quality products to the outdoor clothing industry. This exclusive distribution has strengthened customers association of clothing products under the Born mark and Alfwear.

12. As a result of Alfwear's efforts, advertising and marketing, along with their quality products and great service, Alfwear's Born mark has become famous for outdoor clothing.

13. The Born mark was duly and legally registered by the United States Patent and Trademark Office on after full and fair examination. A copy of the Born mark is attached hereto as Exhibits A.

14. ICON and ALTRA caused an advertisement for footwear to be published on page 105 in the May, 13, 2017 OUTSIDE BUYER'S GUIDE which included marketing phrase "BORN IN THE MOUNTAIN" (see Exhibit B).

15. Alfwear immediately requested that ICON cease and desist use of the trademarked phrase BORN IN

THE MOUNTAINS on May 18, 2017 (see Exhibit C).

CLAIM FOR RELIEF

Federal Trademark Infringement

16. Alfwear repeats and realleges, as though fully set forth herein, the allegations contained in paragraphs 1 through 15 of this Complaint.

17. Alfwear in order to protect its Born mark and put the whole world on notice filed for and obtained Registration No. 3,572,281 for the standard character mark BORN IN THE MOUNTAINS for the following: "clothing, namely, jackets, shirts, pants, shorts, t-shirts, and hats", with a first use date of 2007, which is registered on the Principal Register of the United States Patent and Trademark Office. A true and accurate copy of Registration No. 3,572,281 is attached hereto as Exhibit A. This registration has become incontestable under the provisions of 15 U.S.C. § 1065. The mark is valid and subsisting and the registration has never been cancelled.

18. Alfwear's outdoor clothing is sold through retailers throughout the United States and in other parts of the world, in retailers that handle quality outdoor clothing.

19. Alfwear has extensively advertised its quality outdoor clothing in popular outdoor magazines and other common means of promoting outdoor clothing.

20. Alfwear has invested substantial time, effort and financial resources promoting its Born mark in connection with the marketing and selling of its outdoor clothing in interstate commerce.

21. The Born mark has become well known through widespread and favorable public acceptance and recognition, as an asset of substantial value as a symbol of Alfwear, and its quality products and good will. The consuming public recognizes the Born mark and associates them with Alfwear.

22. Alfwear's Born mark is inherently distinctive and famous as applied to Alfwear's goods that bear the mark. The domain name for Alfwear's business and one location where its outdoor clothing can be ordered is www.kuhl.com.

23. ICON sells footwear under the ALTRA brand in the same retail locations as Alfwear's outdoor clothing including REI.

24. Without Alfwear's consent, ICON has used the exact trademarked phrase "BORN IN THE MOUNTAINS" in connection with the advertising of ICON's goods and/or services.

25. ICON has engaged in its willful infringing activity despite having constructive notice of Alfwear's federal registration rights under 15 U.S.C. § 1072 and, upon information and belief, despite having actual knowledge of Alfwear's Born mark. Multiple executives of the ALTRA brand have purchased clothing items directly from Alfwear that include the trademarked phrase "BORN IN THE MOUNTAINS".

26. ICON's actions are likely to lead the public to conclude, incorrectly, that ICON's goods or services originate with, or are authorized by, Alfwear, which will damage both Alfwear and the public.

27. Upon information and belief, ICON has advertised and offered its goods or services under the phrase "BORN IN THE MOUNTAIN" with the intention of misleading, deceiving or confusing customers as to the origin of ICON's goods or services while trading on Alfwear's reputation and good will.

28. Alfwear has requested in writing that ICON cease and desist from its infringing actions (see Exhibit C).

29. ICON's unauthorized use of the phrase "BORN IN THE MOUNTAINS" in interstate commerce as described above constitutes trademark infringement under 15 U.S.C. § 1114(1) and is likely to cause customer confusion, mistake and/or deception.

30. As a direct and proximate result of ICON's trademark infringement, Alfwear has suffered and will continue to suffer loss of income, profits and goodwill and ICON has and will continue to unfairly acquire income profits and goodwill.

31. ICON's acts of infringement will cause further irreparable injury to Alfwear if ICON is not restrained by this Court from further violation of Alfwear's rights. Alfwear has no adequate remedy at law.

Count 2
Federal Unfair Competition

32. Alfwear realleges and incorporates by reference the allegations of paragraphs 17 through 31, inclusive, as though fully set forth.

33. As a second ground for relief, Alfwear alleges federal unfair competition under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

34. ICON's unauthorized marketing of footwear products in interstate commerce using the exact trademarked phrase "BORN IN THE MOUNTAINS" constitutes a false designation of origin, and/or false representation, that wrongfully and falsely indicates ICON's goods or services as originating from, or connected with, Alfwear and constitutes a use of false descriptions or representations in interstate commerce.

35. ICON's actions constitute federal unfair competition and violate 15 U.S.C. § 1125(a).

36. As a direct and proximate result of ICON's unfair competition, Alfwear has suffered and will continue to suffer loss of income, profits and goodwill, and ICON has and will continue to unfairly acquire income, profits and goodwill.

37. ICON's acts of unfair competition will cause further irreparable injury to Alfwear if ICON is not restrained by this Court from further violation of Alfwear's rights. Alfwear has no adequate remedy at law.

Count 3
Common Law Unfair Competition

38. Alfwear realleges and incorporates by reference the allegations of paragraphs 17 through 37, inclusive as if fully set forth.

39. As its third ground for relief, Alfwear alleges a violation of common law unfair competition.

40. ICON's actions of using the confusing similar phrase "BORN IN THE MOUNTAINS" causes confusion by the public and constitutes common law unfair competition. Alfwear has no adequate remedy at law for damages caused by such common law unfair competition.

Count 4
Dilution

41. Alfwear realleges and incorporated by reference the allegations contained in paragraphs 17 through 40, inclusive as if fully set forth.

42. The Born mark of Alfwear is strong and distinctive, has long been used in connection with Alfwear's goods on which it appears, has long been the subject of substantial advertising and promotion by Alfwear, has been used in advertising throughout the United States, and is widely recognized by customers and those in the trade, is substantially exclusively used by Alfwear and is federally registered as alleged above. Alfwear's Born mark is recognized by the relevant consuming public of the United States as a designation of source for the goods of Alfwear and is therefore a famous mark.

43. The acts of ICON alleged herein were commenced from a time after Alfwear's mark became famous.

44. ICON has made use of the trademarked phrase "BORN IN THE MOUNTAINS" in connection with the goods or services which the ICON has offered in the United States. ICON's acts are in violation of the Lanham Act Section 43(c) in that they are likely to cause dilution by blurring, or by impairing the distinctiveness, of Alfwear's famous Born mark, all to the irreparable injury to, and damage of, Alfwear.

45. ICON's acts are in violation of the Lanham Act, Section 43(c) in that they are likely to cause dilution by tarnishment by harming the reputation of Alfwear's famous Born mark, all to the irreparable injury and damage of Alfwear.

46. ICON committed these acts willfully and with the intention to create an association with Alfwear's famous mark. ICON willfully intended to trade on the reputation of Alfwear's famous mark. ICON willfully intended to harm the reputation of Alfwear's famous mark.

ALLEGATION OF DAMAGE

47. By reason of ICON's acts alleged herein, Alfwear has and will suffer damage to its business, reputation and goodwill and the loss of sales or profits Alfwear would have made but for ICON's acts.

48. ICON may continue to do the acts complained of herein, and unless restrained and enjoined, will continue to do so, all to Alfwear's irreparable damage. It will be difficult to ascertain the amount of the compensation that would afford ICON's adequate remedy for such continuing acts, but such damage is in excess of the jurisdictional amount of this Court. Alfwear's remedy at law is not adequate to compensate it for its injuries threatened.

PRAYER FOR RELIEF

WHEREFORE, Alfwear prays that the Court enter an Order granting the following relief:

a. Entering a judgment that Alfwear's Born mark has been and continues to be infringed by ICON in violation of 15 U.S.C. § 1114(1);

b. Entering a judgment that ICON's use of the phrase "BORN IN THE MOUNTAINS" constitutes dilution in violation of 15 U.S.C. § 1125(a);

c. Entering a judgment that ICON's use of the phrase "BORN IN THE MOUNTAINS" constitutes dilution in violation 15 U.S.C. § 1125(c);

d. Entering a judgment that ICON's use of the phrase "BORN IN THE MOUNTAINS" violates common law unfair competition and infringes Alfwear's common law trademark rights;

e. Permanently enjoining and restraining ICON and each of its agents, officers, employees, attorneys, successors, assigns, affiliates and other persons in privy or active concert or participation with any of them from using the phrase "BORN IN THE MOUNTAINS", or any other designation, alone or in combination with other words or symbols, as a service mark, trade name or otherwise to market, advertise, distribute or identify ICON's services or goods, where that designation would create a likelihood of confusion, mistake or deception with Alfwear's mark;

f. Pursuant to 15 U.S.C. § 1116(a), directing ICON to file with the Court and serve on Alfwear within thirty (30) days after the issuance of an injunction, a report in writing and under oath setting forth in detail the manner and form in which ICON has complied with the injunction;

g. Pursuant to 15 U.S.C. § 1118, requiring ICON and all others under ICON's authority, at their cost, be required to deliver up and destroy all devices, literature, advertising, labels and other material in their possession bearing the phrase "BORN IN THE MOUNTAINS";

h. Ordering ICON to remove the phrase "BORN IN THE MOUNTAINS" from any publications, advertisements, or websites.

i. Awarding Alfwear all damages it sustained as a result of ICON's acts of infringement, unfair competition or dilution, said amounts to be tripled, together with prejudgment interest, pursuant to 15 U.S.C. § 1117;

j. Awarding to Alfwear all profits received by ICON from sales or revenues of any kind made as a result of ICON's infringing actions, said amount to be tripled, after an accounting pursuant to 15 U.S.C. § 1117;

k. Awarding triple actual damages and/or profits pursuant to 15 U.S.C. § 1117(b) because ICON's conduct was willful within the meaning of the Lanham Act;

l. Awarding Alfwear its attorneys' fees and costs pursuant to 15 U.S.C. § 1117 because of the exceptional nature of this case resulting from ICON's deliberate infringing actions;

m. Granting Alfwear such other and further relief to which the Court may deem just.

DATED: May 25, 2017

Respectfully submitted,

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